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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,387	08/11/2000	Amy Haugen	18167-003300US	8884
6449	7590	02/26/2004	EXAMINER	
ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005			JANVIER, JEAN D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/637,387	Applicant(s) ROWNEY ET AL	
	Examiner Jean D Janvier	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) ³⁻³⁰~~3-15 and 30~~ is/are pending in the application.
- 4a) Of the above claim(s) ¹⁶⁻²⁹~~16-29~~ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-15 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u> </u> | 6) <input type="checkbox"/> Other: _____ |

Response To Applicant's Amendments

The Examiner approves the changes made to the specification, to claims 3-15. Further, the Examiner withdraws the 101 Rejection, Claim Objections and the 112 Rejection, while reconsidering the WO 93/01248 related to the IDS (See enclosed PTO Form 1449). However, the Examiner does not approve the new title of the invention. A preferred or suggested title is printed below.

Finally, the Examiner does not consider the newly added claims 16-29 for disclosing a different invention. Indeed, newly submitted independent claim 16 (including dependent claims 17-29) is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Independent claim 16 recites, among other things, “one or more merchant devices including a merchant application module for communicating over the network” and “an application service provider device coupled to the one or more merchant devices and having a local database for storing promotional content information, the application service provider device being adapted to distribute the promotional content information”, which were not previously disclosed. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16-29 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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DETAILED ACTION

Specification

The title of the invention, under 37 CFR 1.72, should be brief and technically accurate so as to help one skilled in the art understand the nature of the invention. Here is a suggested title: --
A System For Determining the Level Of Authentication Required For Redeeming A Customer's Award Credits--.

Claim Objections

Claim30 is objected to because of the following informalities:

Concerning claim 30, the cited limitations are considered in the alternative.

Status of the claims

Original claims 1-2 were canceled by a preliminary amendment. Claims 3-15 and 30 are now pending in the Instant Application, while newly submitted claims 16-29 are withdrawn from consideration as shown above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3-15 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Biorge et al. (hereinafter Biorge), US Patent 5, 806, 045A.

As per claims 3, 10 and 13, Biorge teaches a system for providing incentive credits to a user or customer participating in or more promotion programs via a handheld or portable device (client-user device) 74 for every qualifying transaction conducted at a participating retailer or provider having a provider device 76 wherein the value of the incentive credits is contingent upon the value of a current transaction and wherein the customer's incentive credits are stored on the memory of the portable or handheld device 74 where they can be retrieved during a redemption process. At any given time subsequent to storing the incentive credits on the customer's handheld device, the customer can take the said device 74 to the same retailer or another participating retailer or provider to redeem at least a portion of the incentive credits during a second transaction or a redemption process wherein the stored incentive credits are transmitted from the customer's handheld device 74 to the retailer's POS system or base device 72 (during a synchronization process). In addition, during the redemption process or second transaction (synchronization process), the retailer's POS system or base device 72 transfers newly earned incentive credits to the customer's handheld device 74 permanent memory, based on the value of the second transaction and some other criteria, where they are being added to the existing credit balance (receiving at a client-user device 74 award transaction data or award credits during a transaction from a first base device 72 linked to client-user device or customer

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device 74 and provider device 76 to form a network or system 70 and wherein the system or network 70 is connected in real-time via a communication link 112 to a record-keeping facility or central authority or the outside world over a communications network-fig.3; col. 10: 65 to col. 12: 10; col. 13: 4-22; col. 14: 1-12; col. 15: 28-53).

(See abstract; col. 2: 18 to col. 3: 21; col. 6: 49 to col. 7: 64; figs. 1-3).

At the conclusion of the redemption process or a transaction, the incentive credit total is updated by adding newly earned incentive credits to the existing remaining total following a redemption process. Thereafter, information regarding the transaction that just takes place is stored in the memory of the customer's device 74, in the memory of the provider's 76 and in the memory 102 (local award history database) of the retailer's POS system or base device 72. In the customer's device 74 memory, information such as the transaction amount, the incentive credits earned, the amount of redeemed incentive credits, if any, the name of the provider 76, the product or service purchased is recorded to maintain a journal of all transactions made using this device. Similar information is stored in the memory of the provider 76. In the memory 102 (local award history database) of the base device 72 of fig. 3 or POS system, complete information regarding the transaction, including the identification of the customer and the provider, the transaction amount, the incentive credits earned and redeemed, the good or service purchased and the customer's demographics are recorded thereon (this scenario repeats itself for each single transaction whether it involves a redemption or not). Since the whole process is being conducted off-line, without involving any common authority, the retailer's POS system or the base device 72 will transmit over the communications network the data, including the award information or award credits earned or redeemed, stored in its database 102 (local award history database) to a

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central repository or data warehouse (global award history database) coupled to a computer system or server related to a record-keeping facility or common authority where the data are maintained and utilized for coordinating allocation and redemption of incentive credits among the various providers involved and to further target customers of devices 74, to prevent unauthorized use of the devices 74 and/or to authorize a higher incentive credit allocation and/or redemption level (higher level of authentication) during a transaction or redemption process whereas the POS system or base device 72, providing or handling a low level authentication transaction, cannot process an incentive allocation or redemption process that exceeds a certain preset threshold value (Transaction data including award information or award credits earned or redeemed during a transaction between client-user device 74 and base device 72 are stored in a local history database 102 coupled to a processor or local server 100 of the network or system 70 (LAN) of fig. 3 and wherein the content of the local history database 102 is subsequently transmitted over a communication network (WAN or the Internet) to a global history database coupled to a server for further analysis and wherein the global history database contains information on credits redemption and allocation limits associated with the user of the client-user device 74 and used during a transaction at the retailer's POS or base device 72 to determine for example whether or not the number of award credits that the user wants to redeem is within a preset redemption limit and wherein the user's transaction history is retrieved during a transaction at the POS when the client device 74 communicates with the common authority associated with the global history database to determine if the user's current transaction fits the user's transaction pattern to thereby prevent fraudulent use of the client-user device 74- col. 13: 4-19; col. 15: 7-53).

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(See col. 6: 32 to col. 7: 64; col. 8: 66 to col. 9: 35).

Additionally, in another embodiment, Biorge discloses a process of authenticating or validating a customer's device 74 and the customer himself during a verification process that takes place at the POS system without the input from a common authority, based in part on data stored in base device memory 102 related to network or system 70 (low level authentication). This routine verification occurs during a transaction with or without a redemption process. This routine verification is a twofold process. First of all, the customer's device 74 is checked to determine if it is a proper device for use in the incentive program by having the device 74 exchanged encrypted signals with the base device 72. Second of all, a customer's verification is performed by having him enter a preset user code and comparing the entered user code to a reference user code stored in the memory of the device 74. Only if both the device 74 and the customer are valid will a transaction with or without a redemption process be allowed. In fact, to redeem incentive credits or to earn incentive credits during a transaction at a participating provider, the customer or the bearer of the device 74 must go through the routine verification as disclosed above (low level verification or low level authentication). Following this routine authentication or low level authentication process, the customer of the validated device 74 is allowed by the device 72 to redeem at least a portion of previously earned incentive credits, provided that this portion does not exceed a preset threshold, during a current transaction at a participating provider in accordance with predefined rules or criteria maintained in the global history database of the common authority available online over the communication network (col. 4: 62 to col. 5: 33; col. 10: 65 to col. 11: 20; col. 7: 4-64; col. 12: 38 to col. 13: 3).

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Moreover, in response to a request from the device 72 to specify how many incentive credits the customer wishes to redeem, the customer enters via keyboard 110 the number of previously earned incentives he wishes to use or redeem and the specified number is sent to base device 72 (POS system) processor 110, which determines based on information in memory of the base device 72 (award history database), related to local network 70, if this number exceeds authorized limits. In the affirmative, base processor 100 of the base device 72 enters into an online interaction or communication with a remote common authority (record-keeping facility), having stored in a global history database the customer's transaction data and preset credit redemption and/or credit allocation limits, to obtain further authorization to redeem the exceeded value (high level of authentication required here because the customer's request has exceeded a preset value as determined by base device 72 processor 100 using data stored in its database). Nevertheless, if the specified number is within a predefined range, then the base processor 100 proceeds with the redemption process based on some criteria since the routine validation performed at the beginning of the transaction is sufficient for this kind of transaction (only a low level authentication is required here). During a typical transaction at a provider, processor 100 checks database 102 for more incentive codes for the current transaction and processes them along with other parameters to compute the amount of incentive credits that the customer earns during the transaction. If this value or amount falls within a predetermined range, as determined by processor 100, this amount is added to the memory of the customer's device 74 since the routine verification (low level authentication) performed at the beginning is required for this transaction. However, if the amount exceeds a preset limit, then base processor requires further authorization or authentication and enters into an online interaction with a common remote

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authority to obtain such authorization (high level authentication is needed because of the amount of incentive credits earned during the transaction) (Figs. 4b-4c; col. 13: 4 to col. 14: 22; col. 15: 15 to col. 16: 7).

In addition, even if during a regular transaction in which the routine validation process (low level authentication) is sufficient to conduct the transaction involving incentive credits allocation and/or redemption, the base processor 100 of the base device 72 may request further authorization (high level authentication) from a remote common authority on how to proceed when a customer's transaction seems to depart from the customer's transaction pattern, thereby preventing unauthorized users from using devices 74, which may have been lost. It is further to be understood that, following the routine validation or verification of the client-user device 74 and the user himself, the user may decide to redeem an exceeded number of credits that require further authority (authentication) from the online common authority, coupled to the global history database storing preset credit redemption limit or credit allocation limit and transaction history including credits redeemed and earned related to the user. Finally, during a transaction involving the client-user device 74 and base device or POS 72, subsequent to conducting the routine authentication or verification (low level authentication), the client-user device 74 communicates with the online common authority, over a communication network, which compares the user's transaction pattern stored in the global history database to the current transaction to thereby prevent fraudulent use of the device 74 before base device 72 is allowed to process the user's transaction or redemption (high level authentication) (Col. 11: 21 to col. 12: 10; col. 15: 3 to col. 16: 7).

See figs. 1-9.

As per claims 4-9, 11-12, 14-15 and 30, Biorge teaches a system for providing incentive credits to a user or customer participating in or more promotion programs via a handheld or portable device (client-user device) 74 for every qualifying transaction conducted at a participating retailer or provider having a provider device 76 wherein the value of the incentive credits is contingent upon the value of a current transaction and wherein the customer's incentive credits are stored on the memory of the portable or handheld device 74 where they can be retrieved during a redemption process. At any given time subsequent to storing the incentive credits on the customer's handheld device, the customer can take the said device 74 to the same retailer or another participating retailer or provider to redeem at least a portion of the incentive credits during a second transaction or a redemption process wherein the stored incentive credits are transmitted from the customer's handheld device 74 to the retailer's POS system or base device 72 (during a synchronization process). In addition, during the redemption process or second transaction (synchronization process), the retailer's POS system or base device 72 transfers newly earned incentive credits to the customer's handheld device 74 permanent memory, based on the value of the second transaction and some other criteria, where they are being added to the existing credit balance (receiving at a client-user device 74 award transaction data or award credits during a transaction from a first base device 72 linked to client-user device or customer device 74 and provider device 76 to form a network or system 70 and wherein the system or network 70 is connected in real-time via a communication link 112 to a record-keeping facility or central authority or the outside world over a communications network-fig.3; col. 10: 65 to col. 12: 10; col. 13: 4-22; col. 14: 1-12; col. 15: 28-53).

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(See abstract; col. 2: 18 to col. 3: 21; col. 6: 49 to col. 7: 64; figs. 1-3).

At the conclusion of the redemption process or a transaction, the incentive credit total is updated by adding newly earned incentive credits to the existing remaining total following a redemption process. Thereafter, information regarding the transaction that just takes place is stored in the memory of the customer's device 74, in the memory of the provider's 76 and in the memory 102 (local award history database) of the retailer's POS system or base device 72. In the customer's device 74 memory, information such as the transaction amount, the incentive credits earned, the amount of redeemed incentive credits, if any, the name of the provider 76, the product or service purchased is recorded to maintain a journal of all transactions made using this device. Similar information is stored in the memory of the provider 76. In the memory 102 (local award history database) of the base device 72 of fig. 3 or POS system, complete information regarding the transaction, including the identification of the customer and the provider, the transaction amount, the incentive credits earned and redeemed, the good or service purchased and the customer's demographics are recorded thereon (this scenario repeats itself for each single transaction whether it involves a redemption or not). Since the whole process is being conducted off-line, without involving any common authority, the retailer's POS system or the base device 72 will transmit over the communications network the data, including the award information or award credits earned or redeemed, stored in its database 102 (local award history database) to a central repository or data warehouse (global award history database) coupled to a computer system or server related to a record-keeping facility or common authority where the data are maintained and utilized for coordinating allocation and redemption of incentive credits among the various providers involved and to further target customers of devices 74, to prevent

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unauthorized use of the devices 74 and/or to authorize a higher incentive credit allocation and/or redemption level (higher level of authentication) during a transaction or redemption process whereas the POS system or base device 72, providing or handling a low level authentication transaction, cannot process an incentive allocation or redemption process that exceeds a certain preset threshold value (Transaction data including award information or award credits earned or redeemed during a transaction between client-user device 74 and base device 72 are stored in a local history database 102 coupled to a processor or local server 100 of the network or system 70 (LAN) of fig. 3 and wherein the content of the local history database 102 is subsequently transmitted over a communication network (WAN or the Internet) to a global history database coupled to a server for further analysis and wherein the global history database contains information on credits redemption and allocation limits associated with the user of the client-user device 74 and used during a transaction at the retailer's POS or base device 72 to determine for example whether or not the number of award credits that the user wants to redeem is within a preset redemption limit and wherein the user's transaction history is retrieved during a transaction at the POS when the client device 74 communicates with the common authority associated with the global history database to determine if the user's current transaction fits the user's transaction pattern to thereby prevent fraudulent use of the client-user device 74- col. 13: 4-19; col. 15: 7-53).

(See col. 6: 32 to col. 7: 64; col. 8: 66 to col. 9: 35).

Additionally, in another embodiment, Biorge discloses a process of authenticating or validating a customer's device 74 and the customer himself during a verification process that takes place at the POS system without the input from a common authority, based in part on data

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stored in base device memory 102 related to network or system 70 (low level authentication).

This routine verification occurs during a transaction with or without a redemption process. This routine verification is a twofold process. First of all, the customer's device 74 is checked to determine if it is a proper device for use in the incentive program by having the device 74 exchanged encrypted signals with the base device 72. Second of all, a customer's verification is performed by having him enter a preset user code and comparing the entered user code to a reference user code stored in the memory of the device 74. Only if both the device 74 and the customer are valid will a transaction with or without a redemption process be allowed. In fact, to redeem incentive credits or to earn incentive credits during a transaction at a participating provider, the customer or the bearer of the device 74 must go through the routine verification as disclosed above (low level verification or low level authentication). Following this routine authentication or low level authentication process, the customer of the validated device 74 is allowed by the device 72 to redeem at least a portion of previously earned incentive credits, provided that this portion does not exceed a preset threshold, during a current transaction at a participating provider in accordance with predefined rules or criteria maintained in the global history database of the common authority available online over the communication network (col. 4: 62 to col. 5: 33; col. 10: 65 to col. 11: 20; col. 7: 4-64; col. 12: 38 to col. 13: 3).

Moreover, in response to a request from the device 72 to specify how many incentive credits the customer wishes to redeem, the customer enters via keyboard 110 the number of previously earned incentives he wishes to use or redeem and the specified number is sent to base device 72 (POS system) processor 110, which determines based on information in memory of the base device 72 (award history database), related to local network 70, if this number exceeds

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authorized limits. In the affirmative, base processor 100 of the base device 72 enters into an online interaction or communication with a remote common authority (record-keeping facility), having stored in a global history database the customer's transaction data and preset credit redemption and/or credit allocation limits, to obtain further authorization to redeem the exceeded value (high level of authentication required here because the customer's request has exceeded a preset value as determined by base device 72 processor 100 using data stored in its database). Nevertheless, if the specified number is within a predefined range, then the base processor 100 proceeds with the redemption process based on some criteria since the routine validation performed at the beginning of the transaction is sufficient for this kind of transaction (only a low level authentication is required here). During a typical transaction at a provider, processor 100 checks database 102 for more incentive codes for the current transaction and processes them along with other parameters to compute the amount of incentive credits that the customer earns during the transaction. If this value or amount falls within a predetermined range, as determined by processor 100, this amount is added to the memory of the customer's device 74 since the routine verification (low level authentication) performed at the beginning is required for this transaction. However, if the amount exceeds a preset limit, then base processor requires further authorization or authentication and enters into an online interaction with a common remote authority to obtain such authorization (high level authentication is needed because of the amount of incentive credits earned during the transaction) (Figs. 4b-4c; col. 13: 4 to col. 14: 22; col. 15: 15 to col. 16: 7).

In addition, even if during a regular transaction in which the routine validation process (low level authentication) is sufficient to conduct the transaction involving incentive credits

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allocation and/or redemption, the base processor 100 of the base device 72 may request further authorization (high level authentication) from a remote common authority on how to proceed when a customer's transaction seems to depart from the customer's transaction pattern, thereby preventing unauthorized users from using devices 74, which may have been lost. It is further to be understood that, following the routine validation or verification of the client-user device 74 and the user himself, the user may decide to redeem an exceeded number of credits that require further authority (authentication) from the online common authority, coupled to the global history database storing preset credit redemption limit or credit allocation limit and transaction history including credits redeemed and earned related to the user. Finally, during a transaction involving the client-user device 74 and base device or POS 72, subsequent to conducting the routine authentication or verification (low level authentication), the client-user device 74 communicates with the online common authority, over a communication network, which compares the user's transaction pattern stored in the global history database to the current transaction to thereby prevent fraudulent use of the device 74 before base device 72 is allowed to process the user's transaction or redemption (high level authentication) (Col. 11: 21 to col. 12: 10; col. 15: 3 to col. 16: 7).

See figs. 1-9.

Response To Applicant's Arguments

Applicant's arguments are associated either with the newly added claims or amended claims. First of all, the new claims were restricted by original presentation as shown above and

therefore, these arguments are moot. Second of all, the arguments related to the amended claim limitations were fully considered and addressed in the above Office Action.

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not plausible and thus, the current **Office Action has been made Final.**

Conclusion

Although the following references were not officially used in the office action, they were considered as relevant prior art. Applicant is further directed to review these references.

US Patent 6, 138, 911 discloses a Points distribution and redemption system.

US Patent 6,009,412 to Storey discloses a system for issuing and redeeming award points to a customer over the Internet, wherein the customer's award points are stored in a server database and accessible to the customer subsequent to verifying the customer's identity.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.


For information on the status of your case, please call the help desk at (703) 308-1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325


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SUPERVISORY PATENT EXAMINER
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JDJ
02/21/04